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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,960

07/16/2003

James C. Peterson

009785-0139(15895US01)

9985

23446

7590

10/05/2006

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EXAMINER

DINH, MINH

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/620,960	PETERSON, JAMES C.	
	Examiner	Art Unit	
	Minh Dinh	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-64 is/are pending in the application.
- 4a) Of the above claim(s) is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 25-64 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/8/04, 1/10/05, 4/18/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 25-64 have been examined.

Information Disclosure Statement

2. There are no copies of references C-4 and C-5 listed in the IDS submitted 04/18/06.
3. References C-6 through C-13 and C-30 through C-35 listed in the IDS submitted 04/18/06 have been previously submitted in IDSs filed 03/08/04 and 01/10/05.

Claim Objections

4. Applicant is advised that should claims 25 and 35 be found allowable, claims 54 and 64, respectively, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 35-43 and 55-64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to data containers including encrypted data and are thus functional descriptive material per se. The data containers must be recorded/stored on some computer-readable medium to be statutory.

Please refer to Annex IV of *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, 1300 Off. Gaz. Pat. Office 142 (Nov. 22, 2005) (Patent Subject Matter Eligibility Interim Guidelines).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 25-28, 31-38, 41-47, 50-58 and 61-64 are rejected under 35 U.S.C. 102(a) as being anticipated by Spector ("Updated WinZip Alters Zip Format").

With regards to claims 25-26, 28, 31-32, 35-36, 38, 41-42, 44-45, 47, 50-51, 54-56, 58, 61-62 and 64, Spector discloses a method for generating a ZIP archive (a data container) comprising a data file encrypted using 256-bit AES key ("So WinZip 9.0 supports ... available, as well.")

With regards to claims 27, 37, 46 and 57, Spector does not disclose using Lempel-Ziv type data compression algorithm; however this feature is inherent to ZIP format specification.

With regards to claims 33-34, 43, 52-53, and 63, Spector does not disclose generating symmetric key data and storing the symmetric key data in the ZIP archive; however, these features are inherent to ZIP format specification.

9. Claims 25-28, 33-38, 43-47, 52-58 and 63-64 are rejected under 35 U.S.C. 102(b) as being anticipated by SecuriSys ("SecureZIP Brings Convenience and Security to ZIP files").

With regards to claims 25-26, 35-36, 44-45, 54-56 and 64, SecuriSys discloses a method for generating a ZIP archive (a data container) comprising a data file encrypted using 168-bit Triple Des key ("SecureZIP contains public-key ... the U.S. and Canada").

With regards to claims 27-28, 37-38, 46-47 and 57-58, SecuriSys does not disclose using Lempel-Ziv and Deflate type data compression algorithms; however these features are inherent to ZIP format specification.

With regards to claims 33-34, 43, 52-53, and 63, SecuriSys does not disclose generating symmetric key data and storing the symmetric key data in the ZIP archive; however, these features are inherent to ZIP format specification.

10. Claims 25-28, 30-38, 40-47, 49-58, 60-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Strand et al. (6,934,836).

With regards to claims 25-26, 31-32, 35-36, 41-42, 44-45, 50-51, 54-56, 61-62 and 64, SecuriSys discloses a method for generating a ZIP archive (a data container) comprising a data file encrypted using Blowfish algorithm which uses a symmetric key with a key length up to 448 bits (col. 9, lines 29-35; col. 12, lines 13-36).

With regards to claims 27-28, 37-38, 46-47 and 57-58, Strand does not disclose using Lempel-Ziv and Deflate type data compression algorithms; however these features are inherent to ZIP format specification.

With regards to claims 30, 40, 49 and 60, Strand further discloses that the data file is encrypted before it was compressed (col. 12, lines 13-36)

With regards to claims 33-34, 43, 52-53, and 63, Strand does not disclose generating symmetric key data and storing the symmetric key data in the ZIP archive; however, these features are inherent to ZIP format specification.

Claim Rejections - 35 USC § 103

11. Claims 29, 39, 48 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over SecuriSys as applied to claims 26, 36, 45 and 56 above, and further in view of Nelson ("Data Compression with the Burrows Wheeler Transform"). SecuriSys does not disclose using Burrows Wheeler Transform (BWT) data compression algorithm. Nelson disclose using BWT data compression algorithm (page 4, The Burrows Wheeler Transform and BWT Basics). It would have been obvious to one of ordinary in the art at the time the invention was made to modify SecuriSys method to use BWT data compression algorithm, as taught by Nelson. Original ordering of data elements can be restored with no loss of fidelity.

12. Claims 30-32, 40-42, 49-51 and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over SecuriSys as applied to claims 25, 35, 44 and 55 above, and further in view of Strand.

With regards to claims 30, 40, 49 and 60, SecuriSys does not disclose that the data file has not been previously compressed. Strand discloses a method and system for generating a data container wherein a data file may be compressed and then encrypted or may be encrypted and then subsequently compressed (col. 12, lines 13-36). It would have been obvious to one of ordinary in the art at the time the invention was made to modify SecuriSys method such that the data file could also be encrypted first and subsequently compressed, as taught by Strand, to provide an alternative.

With regards to claims 31-32, 41-42, 50-51 and 61-62, SecuriSys does not disclose that the key length is at least 256 bits. Strand discloses using Blowfish algorithm for which the key length can be as long as 448 bits (col. 9, lines 29-35). It would have been obvious to one of ordinary in the art at the time the invention was made to modify SecuriSys method to use Blowfish algorithm, as taught by Strand. The longer the key is, the more secure encrypted data is.

13. Claims 29, 39, 48 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strand as applied to claims 26, 36, 45 and 56 above, and

further in view of Nelson. Strand does not disclose using Burrows Wheeler Transform (BWT) data compression algorithm. Nelson disclose using BWT data compression algorithm (page 4, The Burrows Wheeler Transform and BWT Basics). It would have been obvious to one of ordinary in the art at the time the invention was made to modify Strand method to use BWT data compression algorithm, as taught by Nelson. Original ordering of data elements can be restored with no loss of fidelity.

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 25, 31-32, 35, 41-42, 44, 50-51, 55 and 61-62 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14, 34, 52, 71, 90, 108, 128 and 147 of copending Application No. 10/945,352. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14, 34, 52, 71, 90, 108, 128 and 147 of copending '352 contain every element of claims 25, 31-32, 35, 41-42, 44, 50-51, 55 and 61-62 of the instant application and as such anticipate(s) claims 25, 31-32, 35, 41-42, 44, 50-51, 55 and 61-62 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schneier, "Applied Cryptography"

Desmond, "PKWare Offers Encryption For .ZIP Files"

Sems, "The Short Version – Compression Software Saves You Time & Money"

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 571-272-3802. The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

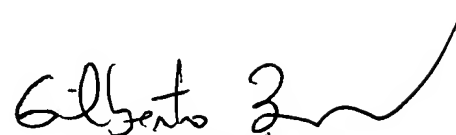
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Minh Dinh
Examiner
Art Unit 2132

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9/30/06

A handwritten signature in black ink, appearing to read "Gilberto Jr.", with a long, sweeping horizontal stroke extending to the right.

GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100